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PATENT APPLICATION
09/781,925

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	CAPERS, et al.
Serial No.:	09/781,925
Filed:	February 12, 2001
Confirmation No.	1795
Group No.:	2182
Examiner:	Angel L. Casiano
Title:	***Integrated Communication Server and Method***

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the rejection of all claims in the Application.

REMARKS

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Non-Final Office Action and the Final Office Action (collectively the "Office Actions") to establish a *prima facie* rejection of the claims in the Application under 35 U.S.C§ 103. The Office Actions rejected Independent Claims 1, 8, 15, and 21 under 35 U.S.C. §103 as allegedly being obvious over U.S. Publication No. 2002/0069272, listing Kim, et al. as inventors ("*Kim*") and U.S. Patent No. 6,782,420 issued to Barrett et al., ("*Barrett*"). However, these rejections fail to meet the required *prima facie* standard for rejections for the reasons set forth below.

Independent Claim 1 is allowable because the proposed combination of *Kim* and *Barrett* fails to disclose, teach or suggest "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." The Office Actions acknowledge that *Kim* does not disclose this limitation. *See* Office Actions, Page 3. Rather, the Office Actions argue that *Barrett* discloses this limitation, indicating that "Barrett et al. teaches a network management (see Abstract) method in which a result set is automatically collected from network elements [Citation 1]. This information is collected by a management server [Citation 2]."[1] This argument is incorrect for two reasons. The first reason is that the claim limitation recites the following:

> "*automatically determining* that one or more network elements are to be included in the integrated communication server based on the result set"

not

> "a result set . . . *automatically collected* from network elements,"

It can not be disputed that these two things are different. That is, a result set automatically collected is not the same thing as automatically determining based on a result set. Accordingly, even if the Office Actions' assertions are correct, such assertions would not support a *prima facie* rejection because the asserted disclosure is different than the claim limitation.

The second reason is that the portions of *Barrett* cited by the Office Actions do not disclose the above limitation. Because each of the Office Actions pointed to different portions of *Barrett*, each of the Office Actions is separately addressed. The Non-Final Office Action

[1] While making the same argument, each of the Office Actions used different portions of *Barrett*. These portions of *Barrett* are addressed below.

pointed to Col. 12, lines 17-20 for Citation 1 and Column 11, line 36 for Citation 2. The entirety of both cited portions, which are within *Barrett*'s claim section, are below:

> an element management server on the computer internet.

(Column 11, line 36.)

> 12. The telecommunications network of claim 1 in which the element management server includes means for automatically polling the plurality of network elements for status information associated with the parent command object.

(Column 12, line 17-20.) Clearly, neither of these limitations disclose "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." Rather, they generally describe polling network elements for information. Further details of this polling is provided at Column 5, lines 6-16 of *Barrett*, clarifying that *Barrett* does not disclose the above limitation.

Applicants previously contended that the above portions (Column 11, line 36 and Column 12, line 17-20) did not disclose the limitations they are alleged to disclose. In response to those contentions, the Final Office Action reiterated the above identical argument, pointing to an additional portion of *Barrett* for both of Citation 1 and Citation 2, namely Column 2, lines 21-37. Column 2, lines 21-37 recites in its entirety:

> In keeping with another important aspect of the invention, complex commands are supported. The element server receives and stores a chain of commands including at least one contingent command, determines the results of at least one of the commands, based upon determined results selectively taking action in accordance with the results of the at least one of the commands.
>
> The managed object commands received from the management computer are automatically converted into a corresponding set commands of the simplified network management protocol. An event distributor provides filtering, routing and distribution of simplified network management protocol traps, commands, command acknowledgments and command responses. An alarm manager provides an indication of current active alarms within the plurality of network elements.

Clearly, this disclosure does not disclose "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." Rather, it generally describes an element server that receives commands, determines the results of the commands, and takes actions in accordance with the results. Furthermore, as identified above, the PTO does not assert that the above citation discloses the limitation – asserting that the above disclosure discloses: "a result set . . . *automatically collected* from network elements" not "*automatically determining* that one or more network

elements are to be included in the integrated communication server based on the result set." Accordingly, for at least these reasons, Applicants submit that Independent Claim 1 and its dependents, Claims 2-7, are allowable. Independent Claims 8, 15, and 21 and their dependents, Claims 9-14 and 16-19, are allowable for analogous reasons.

Independent Claim 1 is additionally allowable because the proposed combination of *Kim* and *Barrett* fails to disclose, teach or suggest "automatically *applying a specified set of rules* to produce *a result set* based on the service option selection and the capacity information" *and* "automatically determining configuration parameters for the one or more network elements *based on the result set*." With regards to these limitations, the Office Action merely points to paragraphs [0030], [0034], and [0035] of *Kim*. But, these portions of *Kim* do not disclose this limitation. Paragraphs [0030], [0034], and [0035] of *Kim* describe a process of updating a server configuration. As described in these paragraphs, when a user modifies a configuration parameter, an intranet server 30 communicates the modification to a server manager 32. The server manager 32 then updates one or more tables that include the parameter. Then, the server manager 32 communicates commands to one or more servers 22, 24, and 26 indicating that the one or more tables have been modified. Clearly, such a process does not disclose the above limitation. Specifically the process described by Paragraphs [0030], [0034], and [0035] of *Kim* mention nothing about automatically *applying a specified set of rules* to produce *a result set*. Further, Paragraphs [0030], [0034], and [0035] mention nothing about automatically determining configuration parameters for the one or more network elements *based on the result set*.

Applicants provided the above contention in previous responses. In response to this contention, the Final Office Action, in addition to reiterating the same argument, indicated that "Kim teaches (Page 3, [0034]) applying rules (updating tables) in response to (i) option selection (see "user modifies") and (ii) capacity information (see "memory space")." Applicants believe the PTO missed the point of the Applicant's contention, which still holds true: *Kim* mention nothing about (1) automatically *applying a specified set of rules* to produce *a result set* and (2) automatically determining configuration parameters for the one or more network elements *based on the result set*. Accordingly, for at least these additional reasons, Applicants submit that Independent Claim 1 and its dependents, Claims 2-7, are allowable. Independent Claims 8, 15, and 21 and their dependents, Claims 9-14 and 16-19, are allowable for analogous reasons.

CONCLUSION

As a *prima facie* rejection has not been established against Applicants' claims, Applicants respectfully request a finding of allowance of all claims in the Application.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corporation, Inc..

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Respectfully submitted,

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